

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of Valerie M. Bennett, et al.

Serial No.: 10/733,625

Filed: December 11, 2003

For: Intelligent Subscription Builder

Art Unit: 2143

Examiner: David E. England

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the Final Rejection in the Office Action mailed July 14, 2008 in the above-identified Application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

/Marcia L. Doubet/

Date: October 8, 2008
Correspondence Address: Cust. No. 43168
P. O. Box 422859
Kissimmee, FL 34742-2859

Marcia L. Doubet, Attorney for Applicants
Registration Number 40,999
Telephone 407-343-7586
Fax 407-343-7587

GROUND OF REJECTION PRESENTED FOR REVIEW

The **Grounds of Rejection** presented for review are a rejection of Claims 1, 3, 4, 6 and 13 - 19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,113,921 to Linker et al. (hereinafter, “Linker”) and a rejection of Claims 6 and 14 under 35 U.S.C. §103(a) as being unpatentable over Linker in view of in view of US Patent No. 6,731,393 to Currans et al. (hereinafter, “Currans”), according to the Office Action mailed July 14, 2008 (hereinafter, “the Office Action”).

ARGUMENT

Applicants reserve the right to argue additional grounds with respect to the patentability of the claims if this Petition is denied.

As stated by the Court of Appeals for the Federal Circuit, “Anticipation under 35 U.S.C. §102 requires the disclosure in a single price of prior art of each and every limitation of a claimed invention.” *Apple Computer Inc. v. Articulate Sys. Inc.*, 57 U.S.P.Q.2d 1057, 1061 (Fed. Cir. 2000), emphasis added. In another case, the Court of Appeals stated that a finding of anticipation requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). In yet another case, the Court of Appeals held that a finding of anticipation requires absolute identity for each and every element set forth in the claimed invention. See *Trintec Indus. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002).

The second element of independent Claim 1 recites:

responsive to the identifying, consulting a mapping to determine a candidate content subscription to be offered to users exhibiting the identified behavior pattern, the candidate content subscription indicating at least one portion of content generated by a content source.

Relative to this subject matter, the Office Action cites column 12, lines 31 - 53 of Linker, and only specifically refers to the “metadata in the user object”. The cited passage describes a user object that can provide access to user metadata including user rights, behavior, preferences and subscription status. But the passage is silent with respect to (1) taking any action “responsive to the identifying” or (2) “consulting a mapping to determine a candidate content subscription to be offered to users”. No “candidate content subscription” is disclosed in this passage from Linker. No mapping is consulted to determine a candidate content subscription.

The fifth element of Claim 1 recites “responsive to acceptance of the offered subscription by the user, storing the markup language document as a trigger associated with the user and the content”. Relative to this subject matter, the Office Action cites column 5, line 20 - 31. Per this passage of Linker, a cookie is used to store a copy of a client identifier at the client during a network session. Behavior and preferences can be stored for each session in a profile. A client’s profile can be employed to customize a graphical user interface with options and products that are related to the client’s behavior.

First, a cookie is a small text file that conforms to hypertext transfer protocol. A cookie does not disclose a markup language document. Further, this portion of the rejection seems to conflict with the rejection of the third element of Claim 1, in which preparation of “a web page with images of products that might be of interest” (from columns 12 - 13) is used to assert that

“generating a markup language document representing the determined candidate content subscription (Claim 1, third element)” is disclosed by Linker. As noted above, a cookie is not a markup language document. The “web page” from columns 12 - 13 is not used as a trigger; rather, it appears that the web page is employed simply to display images and products (see column 12, lines 58 - 60).

Further, per the fifth element of Claim 1, the markup language document is *stored responsive to the user selection of a subscription*, but previously, per the fourth element of Claim 1, a subscription was offered “to the candidate content subscription using a graphical user interface constructed using the first markup language document”. The web page from column 12, lines 58 - 60 used at least in part to teach the markup language document is employed *only* to display images and related products. The web page is not employed to *construct* a graphical user interface, per the fourth element of Claim 1. The rest of the cited passage from column 12, line 54 - column 13, line 30 does not disclose, teach or suggest the construction of a graphical user interface using a markup language document.

The sixth element of Claim 1 recites, in part, “subsequently evaluating the content generated by the content source using the trigger”. Relative to this subject matter, a passage from column 8, lines 35 - 55 of Linker is cited. However, this passage does not teach, suggest or disclose the use of a trigger to evaluate content generated by a content source. As discussed above, per Claim 1, the trigger is the stored markup language document. The use of a trigger to perform this functionality is simply not found in Linker.

Accordingly, as demonstrated above, Applicants respectfully submit that independent

Claim 1 is deemed patentable over Linker. Dependent Claims 3, 4, 6 and 13 - 19 are deemed patentable by virtue of (*inter alia*) the patentability of the independent claim from which they depend. Further differences between some of the dependent claims and the cited art will now be discussed.

Dependent Claim 3 recites, in part, “revising the markup language document to include each of the at least one condition prior to the storing”. Relative to this subject matter, the Office Action cites a passage from column 7, line 60 - column 8, line 34. As discussed above, the Office Action erroneously asserted that the markup language document is disclosed by the web page from lines 58 - 60 of column 12. The passage of Linker cited relative to Claim 3 does not address revising a markup language document, much less revising a markup language document to include at least one condition prior to storing the document. Accordingly, Applicants submit that dependent Claim 3 further distinguishes over the cited art.

Dependent Claim 6 recites “the subsequently evaluating further comprises scheduling time on an electronic calendar of the user when any of the at least one portion of the content is considered a match to the trigger.” Relative to this subject matter, the Office Action cites column 12, line 57 - column 13, line 10 of Currans. This passage addresses a document 12000 that does not originate from a content provider, but rather is stored locally and may be a daily calendar which has been requested by the user to print automatically at a certain time of day. This passage does not teach, suggest or disclose scheduling time on a user’s electronic calendar. No portion of the content of the document in Currans is compared to a trigger to see if it is considered a match. Accordingly, Applicants submit that dependent Claim 6 patentably distinguishes over the combination of Linker and Currans.

Dependent Claim 14 recites “the subsequently evaluating is invoked responsive to a timer.” Relative to this subject matter, the Office Action cites column 12, line 57 - column 13, line 10 of Currans. This passage addresses a document 12000 that does not originate from a content provider, but rather is stored locally and may be a daily calendar which has been requested by the user to print automatically at a certain time of day. Currans does not teach, suggest or disclose that an evaluation is invoked responsive to a timer. Rather, Currans simply discloses how a locally stored document may be printed at a certain time every weekday. No evaluation of anything is invoked responsive to a timer, as per dependent Claim 14. Accordingly, Applicants submit that dependent Claim 14 patentably distinguishes over the combination of Linker and Currans.

To establish a prima facie case of obviousness under 35 USC § 103, the modification or combination must teach or suggest all of Applicant’s claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As discussed above, the cited references, Linker and Currans, do not teach or suggest all of Applicants’ claim limitations found in Claims 6 and 14. Accordingly, a prima facie case of obviousness has not been established, and Claims 6 and 14 are patentable over the cited art.

In view of the above, Applicants respectfully request that the rejection in the Office Action be reversed by the appeal conference prior to the filing of an Appeal Brief.